

REMARKS

Claims 1 to 20 are in this application and are presented for reconsideration. By this amendment, Applicant has amended claims 4, 5, 10, 17, and 18 to improve the clarity and the style of this Application.

The claims have been objected to for informalities. By this amendment, Applicant has amended several claims to overcome the Examiner's objections and respectfully makes assertions for overcoming the objections and the rejections of the outstanding office action dated November 1, 2005 in the following paragraphs.

Claim Objections

Claims 4, 5, 10, 17, and 18 have been objected to because of the use of the terms "high" and "low" which, according to the position taken by the Patent Office, rendered the claims ambiguous, because the necessary degree of high Tg and/or low Tg have not been defined.

Applicant respectfully disagrees with this position. The terms are used in context. The term "high" as used in the claims means Tg in the range from 0°C to 40°C and the term "low" as used in the claims means Tg in the range from -30°C to 0°C. This is disclosed in paragraph 0015 of the specification, the pertinent part is reproduced as follows:

"High Tg polyurethane resin is a polyester product composed of an isophoronediiisocyanete and polycaprolactonediol, andin the resin Tg is in the range from

0° to 40 °C... low Tg polyurethane resin is a polyester product composed of isophorone diisocyanate and polyesterdiol, and in this resin, Tg is in the range from -30 °C to 0 °C"

Since this range has already been specified in the specification and the claims are read in light of the specification, it is applicant's position that the claims need not be amended to include these ranges. However, to further advance prosecution of this Application, applicant has amended the claims 4, 5, 10, 17, and 18 to overcome the claim objections.

Additionally, claims 5 and 18 have been objected to because the use of the term "ultra high" renders the claim ambiguous according to the position taken by the Patent Office. This position is based on an argument that the term is neither defined in the specification nor does it have a well-defined meaning in the art.

Applicant respectfully disagrees with this position as well. The term "ultra high" as used in the "ultra high molecular weight" refers to the molecular weight in the range from 600,000 to 1,200,000. This range has also been disclosed in the specification, specifically in paragraph 0016. The relevant portion of paragraph 0016 is reproduced below:

"In the invention according to claim 5, the mixing ratio of polyvinyl pyrrolidone to the composite polyurethane acceptable as an appropriate addition rate is in the range from 1:2.5 to 1:5 by solid weight, and more preferably in the range from 1:2.5 to 1:3. The molecular weight of the polyvinyl pyrrolidone used is in the range from 600,000 to 1,200,000."

To further the prosecution of this case, Applicant has amended claims 5 and 18 to include these ranges as well.

Double Patenting.

Claims 1 to 4, 6 to 17, and 19 to 20 have been provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1 to 20 in view of paragraphs [0039, 0063, 0079, and example 1] of copending Application number 10/890,701. This rejection is based on the Office position that although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap with the claims of 10/890, 701, and they would be obvious.

Applicant respectfully requests reconsideration. Applicant notes that the subject matter of the present invention is an "antistatic ink for backing up.", while the invention of the application number 10/891701 relates to an "adhesive agent". Therefore, the object of the present invention differs from the object of the invention that is disclosed in the application number 10/891701. Different inventions are distinct from each other and claims describing one such invention can not be used to reject the claims describing the other distinctive invention. For instance, if an automobile and a computer are both described as "an apparatus with windows", that does not mean the two apparatus are obvious of each other. The inventions are classified in different classes and are searched under different criteria. Such inherent differences can not be overlooked when considering whether one invention is a duplicative of another. Therefore, applicant requests that the double patenting rejection be withdrawn in light of the

fact that the two applications pursue two different objectives with two different inventions.

It is applicant's position that the current amendment has overcome the claim objections and has overcome the double patenting rejection in light of the above remark. Applicant respectfully requests that the examiner favorably consider the claims as now presented in view of the discussion above. Applicant respectfully solicits allowance of this application.

It is applicant's vision that all claims are now allowable. Should the examiner determined that issues remain that have not been resolved by this response, the examiner is requested to contact applicant's representative at the number listed below.

Favorable action is requested.

Respectfully submitted
for Applicant,

By:



John James McGlew

Registration No. 31,903

McGLEW AND TUTTLE, P.C.

JJM/DWK:

71389.12

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 13-0410.

CERTIFICATE OF FACSIMILE TRANSMISSION

I HEREBY CERTIFY THAT THIS PAPER FOR SERIAL NO. 10/829,073 (11 PAGES IN ALL) IS BEING FACSIMILE TRANSMITTED TO THE PATENT AND TRADEMARK OFFICE FACSIMILE NUMBER 571-273-8300 ON THE DATE SHOWN BELOW.

MARIA NOWELL

NAME OF PERSON SIGNING CERTIFICATION

Maria Nowell

SIGNATURE

DATED: February 1, 2006
McGLEW AND TUTTLE, P.C.
BOX 9227 SCARBOROUGH STATION
SCARBOROUGH, NEW YORK 10510-9227
TELEPHONE: (914) 941-5600
FACSIMILE: (914) 941-5855